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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,486	11/15/2001	Han Htun	30426.1USD1	3266

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EXAMINER

SISSON, BRADLEY L

ART UNIT PAPER NUMBER

1634

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<b>Application No.</b> 10/001,486	<b>Applicant(s)</b> HTUN ET AL.	
	<b>Examiner</b> Bradley L. Sisson	<b>Art Unit</b> 1634	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 18 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 18 September 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: 18.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 16 and 17.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

  
 Bradley L. Sisson  
 Primary Examiner  
 Art Unit: 1634

Continuation of 11. does NOT place the application in condition for allowance because: Contrary to assertions made at page 5 of the response received 18 September 2006, the Office is not imposing a requirement that applicant demonstrates 'commercial success.' No such requirement has been made or implied. Further, while such a showing could be relevant if the claims had been rejected under 35 USC 103(a), however, in the present case, no such rejection is outstanding, and 35 USC 112, first paragraph, rejections cannot be overcome by such secondary considerations

At page 3, bridging to page 5 of the Final Office Action, mailed 18 May 2006, the deficiency of the present disclosure is outlined. Applicant's remarks have not been found to indicate where the disclosure does in fact fully enable and adequately describe the alternative embodiments encompassed by the claims. While an applicant is not required to teach each and every possible embodiment encompassed by the claims, the specification still must provide a full, clear, and concise description of the genus encompassed by the claims so that one would be readily able to determine if a species fell within the claims' scope, and to also reasonably suggest that applicant had possession of the invention at the time of filing. In support of this position, attention is directed to the decision in *In re Shokal*, 113 USPQ 283 (CCPA 1957) wherein is stated:

It appears to be well settled that a single species can rarely, if ever, afford sufficient support for a generic claim. In *re Soll*, 25 C.C.P.A. (Patents) 1309, 97 F.2d 623, 38 USPQ 189; In *re Wahlforss et al.*, 28 C.C.P.A. (Patents) 867, 117 F.2d 270, 48 USPQ 397. The decisions do not however fix any definite number of species which will establish completion of a generic invention and it seems evident therefrom that such number will vary, depending on the circumstances of particular cases. Thus, in the case of small genus such as the halogens, consisting of four species, a reduction to practice of three, or perhaps even two, might serve to complete the generic invention, while in the case of a genus comprising hundreds of species, a considerably larger number of reductions to practice would probably be necessary.

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We are of the opinion that a genus containing such a large number of species cannot properly be identified by the mere recitation or reduction to practice of four or five of them. As was pointed out by the examiner, four species might be held to support a genus, if such genus is disclosed in clear language; but where those species must be relied on not only to illustrate the genus but to define what it is, the situation is otherwise.

In the present case applicant asserts that "any cell" could be used, yet provides but a single species to enable the genus. Such a minimal showing has not been found to be fully enabling.

Therefore, and in the absence of convincing evidence to the contrary, the rejection is maintained against claims 16 and 17.